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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/817,538	03/26/2001	Zuomei Li	106101.144	6847

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EXAMINER

LACOURCIERE, KAREN A

ART UNIT

PAPER NUMBER

1635

DATE MAILED: 09/25/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application No.

09/817,538

Applicant(s)

LI ET AL.

Examiner

Karen A. Lacourciere

Art Unit

1635

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 07 August 2003 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
 - (b) ☐ they raise the issue of new matter (see Note below);
 - (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
 - (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____

3. ☒ Applicant's reply has overcome the following rejection(s): See Continuation Sheet.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____

Claim(s) objected to: _____

Claim(s) rejected: 1-3 and 5-7.

Claim(s) withdrawn from consideration: _____

8. ☐ The proposed drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____
10. ☐ Other: _____

Karen A. Lacourciere

Continuation of 3. Applicant's reply has overcome the following rejection(s): The Terminal Disclaimer filed August 7, 2003 is proper and has been recorded and is sufficient to overcome the rejection of record of 1-3, 5 and 7 under the judicially created doctrine of obviousness-type double patenting. The amendments to claim 7 filed August 7, 2003 overcome the rejection of record under 35 USC 112, second paragraph.

Continuation of 5. does NOT place the application in condition for allowance because: Applicant argues that the Yoshida et al. does not motivate the skilled artisan to make an antisense inhibitor of HDAC-1 because the paper supplies a solution to providing a more specific and potent inhibitor of histone deacetylase. Applicant argues the motivation cited by the Examiner from Yoshida et al. is selective and does not consider other statements within Yoshida et al. Applicant points to passages within Yoshida et al. and argue these positive statements towards the inhibitor of Yoshida et al. would not motivate the skilled artisan to make a specific antisense targeted to HDAC-1. This has not been found to be persuasive because Yoshida et al. clearly teach that there is a need to find a more potent and specific inhibitor of histone deacetylase for analysis of histone deacetylase activities. Yoshida et al. further discuss how the only other known histone deacetylase inhibitor, n-butyrate, has additional, multiple non-specific effects on cells. Yoshida et al. indicate that TSA appears to be a more specific inhibitor with fewer side effects than n-butyrate and therefore a useful tool for determining histone deacetylase activities in cells. The skilled artisan would clearly recognize the need to have other specific inhibitors of histone deacetylase as tools in elucidating the function of histone deacetylase, for example, to determine what TSA effects are, in fact, specific for histone deacetylase function, rather than non-specific TSA effects. Activity analysis for histone deacetylase, as taught and motivated by Yoshida et al., clearly would require multiple inhibitors as research tools. Yoshida et al. do not suggest that TSA is the only specific inhibitor needed for this analysis, and further, Yoshida et al. point to the shortcomings of the only other known inhibitor and teach comparative analysis using both inhibitors to elucidate specific versus non-specific effects. The skilled artisan would clearly recognize that other comparative experiments using other specific inhibitors would be useful and that antisense would fulfill that need, based on the teachings of the secondary references.


KAREN A. LACOURCIERE, PH.D.
PRIMARY EXAMINER